

REMARKS

Claims 1, 10, and 14 have been amended. Claims 2-6 were previously canceled, and claims 7-9 and 11-13 are canceled herein without prejudice or disclaimer. Claims 1, 10, and 14 remain under consideration.

As the amendments filed by Applicants on November 16, 2009 have not been entered according to the Advisory Action, those amendments are repeated here. Claim 1 has been amended to remove recitation of components (B) and (D), and to remove recitation of (C-2) where R3 is an alkyl group having 7 to 29 carbon atoms. Claim 10 has been amended to remove recitation of component (A), and to include the limitations of claims 11 and 12. Claim 14 has been amended for clarity. In addition, claims 1, 10, and 14 have been amended to delete recitation of formula (1) as a possible representative of component C-1. That is, C-1 is now defined only by formulas (2) and (3). No new matter has been added.

Rejection Under 35 USC § 102(b)

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by Baba (WO/02/092735A1). The rejection is respectfully traversed.

Claim 1 is directed to a lubricant composition that comprises a base oil as well as components (A) and (C). The Office Action states that Baba discloses N-oleyl sarcosinic acid, as well as sarcosines and their derivatives, meeting the limitation of C-1-1. However, the claims as amended no longer recite the C-1-1 genus, and therefore no longer read on N-oley^l sarcosine as a possible component C.

As for (C-2), the case where R3 is an alkyl group having 7 to 29 carbon atoms has been deleted by amendment, and therefore the behenic acid (C₂₂H₄₄O) component disclosed by Baba is no longer within the presently claimed invention.

Thus the lubricative composition of claim 1, comprising a base oil as well as components (A) and (C), is not disclosed by Baba. Further, the lubricative composition of claim 10 comprising a base oil, component (C), and at least one additive selected from components (B) and (D), also is not disclosed by Baba, since components (C) and (D) are not disclosed by Baba. Consequently, the rejection has been overcome and should be withdrawn.

Rejection Under 35 USC § 102(b) or § 103(a)

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under U.S.C. 103(a) as

obvious over Baba (WO02/092735A1). The rejection is respectfully traversed.

Claim 13 has been cancelled, so its rejection is moot.

Regarding claim 14, as argued above, Baba's disclosure of N-oley1 sarcosine no longer falls within the recited genus of component C. Baba also does not teach or suggest component (C-2), as behenic acid no longer falls under the present claim.

Thus Baba does not teach or suggest the composition of claim 14, consisting essentially of a base oil and component (C) (either (C-1) or (C-2)), and the rejection should be withdrawn.

Rejection Under 35 USC § 103(a)

Claims 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as allegedly obvious over Baba (WO 02/092735A1) in view of Yokota et al. (US 2002/0035043A1). The rejection is respectfully traversed.

Claims 7-8 and 11-12 have been cancelled, so the rejection is moot with respect to those claims. As claims 11 and 12 have been incorporated into claim 10, the rejection is discussed below as it might apply to claim 10.

As argued above, Baba does not teach or suggest either component (C-1) or component (C-2).

Yokota is cited as teaching the ester oiliness improver of component (D) which is an ester of a polyhydric alcohol and a fatty acid of a monobasic acid. However, since neither Baba nor Yokota provide a teaching or suggestion of either (C-1) or (C-2), amended claim 10 is not obvious over Baba in view of Yokota. Withdrawal of the rejection is respectfully requested.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter which would expedite allowance of the present application.

Respectfully submitted,

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Dated: December 14, 2009

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